

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Application of: Sebastian KRAUFVELIN <i>et al.</i>	Confirmation No.: 2122
Application No.: 10/529,697	Examiner: Torres, Marcos L
Filed: October 3, 2003	Group Art Unit: 2617

For: PROVISION OF INFORMATION REGARDING A MOBILE STATION

Commissioner for Patents
Alexandria, VA 22313-1450

REPLY BRIEF

Dear Sir:

This Reply Brief is submitted in response to the Examiner's Answer mailed January 25, 2011.

I. STATUS OF THE CLAIMS

Claims 1-21 are pending in this appeal. Claim 22 has been canceled. No claim is allowed. Claims 1, 10, 13, and 17-21 were previously presented. Claims 2-9, 11, 12, and 14-16 are original claims. This appeal is therefore taken from the final rejection of claims 1-21 on May 27, 2010.

II. GROUND OF REJECTION TO BE REVIEWED

Claims 1, 4-6, 9-14, 16, 18, and 19, were finally rejected for obviousness under 35 U.S.C. § 103(a) based on *Murray* (US 6,484,033) in view of *Cedervall et al.* (US 2004/0203900).

Claim 2 was finally rejected for obviousness under 35 U.S.C. § 103(a) based on *Murray* (US 6,484,033) and *Cedervall et al.* (US 2004/0203900) in view of *Wilson et al.* (US 7,203,502).

Claims 3, 15, and 20 were finally rejected for obviousness under 35 U.S.C. § 103(a) based on *Murray* (US 6,484,033) and *Cedervall et al.* (US 2004/0203900) in view of *Havinis et al.* (US 6,169,899).

Claims 7, 8, and 21 were finally rejected for obviousness under 35 U.S.C. § 103(a) based on *Murray* (US 6,484,033) and *Cedervall et al.* (US 2004/0203900) in view of *Miriyala et al.* (US 7,024,195).

Claim 17 was finally rejected for obviousness under 35 U.S.C. § 103(a) based on *Murray* (US 6,484,033) and *Cedervall et al.* (US 2004/0203900) in view of *Nakagawa* (US 5,621,414).

III. ARGUMENT

Appellants maintain and incorporate the positions presented in the Appeal Brief filed October 18, 2010, but present further refutation of certain assertions presented in the Examiner's Answer.

At page 9 of the Answer, responsive to Appellants' argument that in *Cedervall et al.*, in response to a request for location-based services, the location-based service, itself, not "information regarding services," as claimed, is provided, the Examiner asserted that "any information related, about, [or] concerning the service may read on the claim" because the claim does not further limit "information regarding services." Appellants respectfully disagree.

In *Cedervall et al.*, it is the location-based service, not any information (whether it be related, about, or concerning the service) regarding the service, that is provided in response to the request for location-based services. The term "information regarding services" is not broad

enough to cover the service itself. The Examiner's position is contrary to well settled rules of claim interpretation that when giving a claim its broadest reasonable interpretation, the words of a claim must be read as they would be interpreted by those of ordinary skill in the art. *In re Baker Hughes Inc.*, 215 F.3d 1297, 55 USPQ2d 1149 (Fed. Cir. 2000); *In re Morris*, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997); M.P.E.P. 2111.01. "Although the PTO must give claims their broadest reasonable interpretation, this interpretation must be consistent with the one that those skilled in the art would reach." *In re Cortright*, 165 F.3d 1353, 1369, 49 USPQ2d 1464, 1465 (Fed. Cir. 1999). The provision of the actual service requested in response to a request for that service is not a provision of information "regarding" the service, as claimed.

The Examiner cited paragraphs [0069]-[0070] of *Cedervall et al.* as teaching details about services, such as location data, driving direction, or available local services. However, to whatever extent these "details" may be considered "information regarding services," such information is not provided **"in response to a notification that the mobile station is present in the geographical area of interest,"** as recited in independent claim 1, for example.

At page 10 of the Answer, responsive to Appellants' argument that actually providing a service is not equivalent to providing information regarding that service, the Examiner asserted that "information regarding services" is "equated to information with respect or concerning a service and a service is a work done that benefits another." Thus, the Examiner concluded that "providing information such as location data, driving direction, or available local services clearly reads on information regarding services, because the information is concerned to a service and no exclusion is presented in the claim." Respectfully, the Examiner is interpreting claim features in a vacuum, without regard to the claimed subject matter as a whole.

Again, to whatever extent that information such as location data, driving direction, or available local services clearly reads on information regarding services may be interpreted as “information regarding services,” and Appellants do not necessarily agree with this assumption, such information is not provided **“in response to a notification that the mobile station is present in the geographical area of interest,”** as recited in independent claim 1, for example.

The claimed invention requires that the information regarding services be provided **“in response to a notification that the mobile station is present in the geographical area of interest.”** Nothing in *Cedervall et al.* teaches that information such as location data, driving direction, or available local services, is provided information regarding services “in response to a notification that the mobile station is present in the geographical area of interest.”

The Examiner cited paragraphs [0024], [0069], and [0070] of *Cedervall et al.* for the asserted teaching of providing “in response to a notification that the mobile station is present in the geographical area of interest.” However, it is clear from a review of these cited portions of the reference, that there is no provision of information regarding services “in response to a notification that the mobile station is present in the geographical area of interest,” with paragraph [0024] directed to using the unique identifier of a wireless unit to determine location information associated with the wireless unit and a location-based service provider using the location information to provide localized information to a requesting party, and paragraphs [0069]-[0070] of *Cedervall et al.* relating to limiting searches by a mobile unit to a locality associated with the mobile, or wireless, unit, and a service provider generating a page including localized information relative to the wireless unit.

At pages 11-12 of the Answer, responsive to Appellants’ argument that *Murray* describes “event information,” “event location,” “event backup information,” and “event criteria

parameters,” but does not describe either “an area event notification” or “receiving an area event notification request from a client,” the Examiner asserted that the claimed invention requires the area event notification to request a scheduled task with two requirements; an identity and a geographical area or location, and *Murray* discloses both. Appellants’ respectfully disagree.

The Examiner cited Fig. 6 and Fig. 7, steps 166 and 168, as well as col. 10, lines 19-24, of *Murray*, as disclosing an event notification including time, location and criteria parameter “which are a request to perform a task when there is a match.” However, Fig. 6 describes a server memory having events 128, which may include time, location, and criteria parameters, but this is no suggestion that the events described therein are the subject of an “an area event notification” or “receiving an area event notification request from a client.” Fig. 7 is a flowchart describing the operation of an application server, where event data is received, the data is processed, current information is received and processed, and a check is made to see if there is a criteria match at step 166. If there is a match, an action is performed at step 168. At step 160, an application server 76 receives event information, but the event information described in *Murray* is hardly an “area event notification request,” as claimed, as the claimed area event notification request must contain “information associated with the identity of a mobile station and a geographical area of interest.” The application server 76 in *Murray* is not requesting an “area event notification,” or anything else. Rather, the application server 76 stores an event location and one or more event criteria parameters in a server memory. A server processor 150 processes a current location of a wireless communication device and a server event management application 82 compares the current location with the event location. In response to the comparison and the event location exceeding the event criteria parameters, the server processor 150 sends a server command to a system controller 24. There is no description or suggestion in *Murray* of “receiving an area

event notification request from a client at a location service entity provided in association with a communication system, the **area event notification request containing information associated with the identity of a mobile station and a geographical area of interest.**”

In *Murray*, any event information is **received from a** wireless communication device 32 (identified by the Examiner as corresponding to the “client”). This is in direct contrast to the claimed subject matter, which recites, “receiving an area event notification **request from a client.**” Thus, in accordance with the claimed invention, **the client** requests area event notification; it **does not send** such event notification as would appear to be the case in *Murray*. Therefore, even if the event information in *Murray* could be construed to correspond to the claimed “area event notification,” which, Appellants assert, cannot be so construed, *Murray* **teaches away** from the instant claimed subject matter, which is evidence of non-obviousness.

As previously argued in the Appeal Brief, the Examiner’s assertion, as page 2 of the final Office Action that *Murray* discloses both an identity and a geographical location at col. 7, lines 53-65, and col. 10, lines 19-24, concluding that *Murray* discloses the claim feature of “receiving an area event notification **request from a client,**” is erroneous.

The cited portion of column 7 of *Murray* relates to an event schedule including an identification of the mobile device and receiving current time, but no location. The cited portion of column 10 discloses that event information may include event time and event location, but even if these two portions of *Murray* can be construed to form a teaching of a combination of identity and geographical information that could, *arguendo*, constitute “an area notification request,” the claimed invention recites, “receiving an area event notification **request from a client.**” The client in *Murray* is not requesting an area event notification. Thus, again, even assuming that the event information in *Murray* could be construed to correspond to the claimed

“area event notification,” which, Appellants assert, cannot be so construed, *Murray* teaches away from the instant claimed subject matter because in *Murray*, at best, any event information is **received from the client**; the client is not doing the requesting.

The Examiner’s response to Appellants’ argument is that such argument constitutes a “piecemeal analysis” (Answer-page 13). Appellants respectfully disagree. It is not a piecemeal analysis to analyze each portion of the reference cited by and relied on by the Examiner to point out that such reliance is misplaced because even if the various teachings of the cited portions of the reference are construed in a light most favorable to the Examiner, the claimed invention is not taught or suggested because any event information is **received from the client** in *Murray*; the client is not doing the requesting, as required by the claimed invention.

At pages 13-14 of the Answer, responsive to Appellants’ argument that claim 2 is separately patentable because the feature of “wherein the monitoring is activated at the mobile station” is absent from the teachings of *Murray* and *Cedervall et al.*, and *Wilson et al.* provides no incentive to the skilled artisan to modify the *Murray/Cedervall et al.* combination to provide this feature, the Examiner asserted that Appellants are “combining two different unrelated limitations.” In particular, claim 2 requires activating the monitoring at the mobile station but is silent as to where the monitoring takes place. The Examiner asserted that it is immaterial that the monitoring in *Murray* is performed at the application server rather than at the monitored mobile device because claim 2 does not require monitoring at the mobile device; it is only activation at the mobile device that is required. Appellants respectfully disagree.

Even if *Wilson et al.* did teach some activation of a monitoring function, there would have been no reason to modify *Murray* by including **activation** of a monitoring function **at the mobile station**, as recited in claim 2, since this would render *Murray* unsuitable for its intended purpose

of using an application server for processing the event data and current location of a mobile device and comparing these values. The activation is that recited in claim 1, i.e., “activating monitoring for an event indicative of a change in the presence status of the mobile station relative to said geographical area of interest.” Thus, it is this activation that claim 2 restricts to being performed at the mobile station. Since the activation must be at the mobile station, in accordance with claim 2, and modification of *Murray* to include **activation** of a monitoring function **at the mobile station** would render *Murray* unsuitable for its intended purpose, it is immaterial as to whether or not *Wilson et al.* teaches an activation at the mobile station.

At pages 17-18 of the Answer, responsive to Appellants’ argument that claims 3, 15, and 20 are separately patentable from their independent claims, the Examiner asserted that Appellants are arguing the references individually. Appellants respectfully disagree.

Appellants were merely focusing on the teachings of *Havinis et al.* because the Examiner acknowledged that the feature of “wherein the monitoring is based on the identity of at least one cell of the communication system selected based on said information of the area of interest” was missing from *Murray* and *Cedervall et al.*, relying on *Havinis et al.* to fill in the gaps. Since there is no there is no disclosure or suggestion in *Havinis et al.* of basing the monitoring of an operation as claimed (i.e., “monitoring for an event indicative of a change in the presence status of the mobile station relative to said geographical area of interest”) “on the identity of at least one cell of the communication system selected based on said information of the area of interest,” for reasons previously argued in the Appeal Brief, Appellants have shown that none of the applied references suggest the claim feature of “wherein the monitoring is based on the identity of at least one cell of the communication system selected based on said information of the area of interest,” thus undermining the Examiner’s assertion of a *prima facie* case of obviousness.

At pages 18-19 of the Answer, responsive to Appellants' argument that claims 7, 8, and 21 are separately patentable from their independent claims because there is no indication of any concern by *Miriyala et al.* with the "shape" of the coverage area, the Examiner asserted that *Miriyala et al.* discloses defining an area and its shape in Figs 1 and 2, and col. 3, lines 42-50 and col. 4, lines 21-28. Appellants respectfully disagree.

Miriyala et al. may depict coverage areas 24 and 26 with a definite shape (in Fig. 1, for example), but that is just an arbitrary and convenient way to depict such coverage areas in the context of the invention. There is, however, no indication, whatsoever, in *Miriyala et al.* that the area of interest is "defined by means of a shape of the area." There is no such definition of the area of interest in *Miriyala et al.* and the Examiner is clearly wrong to rely on some arbitrarily drawn coverage area shape in Fig. 1 of *Miriyala et al.* as disclosing or suggesting "wherein the area of interest is defined by means of a shape of the area," as in claim 7, for example.

At pages 20-21 of the Answer, responsive to Appellants' argument that claim 17 is separately patentable from its independent claim in its recitation of "confirming the location of the mobile station responsive to the signaling location, to ensure the location corresponds to the area of interest," the Examiner asserted that *Nakagawa* discloses confirming the location of the mobile station responsive to the signaling or transmitting location to ensure the location corresponds to the area. Appellants respectfully disagree.

Col. 1, lines 7-18, of *Nakagawa* does discuss a "location confirming system," but discloses nothing regarding "confirming the location of the mobile station responsive to the signalling location, **to ensure the location corresponds to the area of interest,**" as claimed.

Also, responsive to Appellants' argument that the rationale for combining *Nakagawa* with *Murray and Cedervall et al.* is so defective as to constitute no rationale at all, the Examiner

asserted that “the technique for confirming a value or measurement in the case of location is a **common and well-known technique** to verify that the initial value or measurement are correct.”

The Examiner’s new assertion in the Answer that the feature of claim 17 is a “**common and well-known technique**” has blindsided Appellants as this is the first time the Examiner has asserted what is essentially “Official notice.” Up until now, the Examiner has relied on the cited references to *Nakagawa*, *Murray* and *Cedervall et al.* to supply this teaching.

Appellants respectfully submit that the conclusion that “the technique for confirming a value or measurement in the case of location is a **common and well-known technique** to verify that the initial value or measurement are correct” is without any factual basis. Otherwise, the Honorable Board is respectfully requested to refuse to consider, at this late point in the prosecution, the Examiner’s assertion that the feature of claim 17 is “common and well-known” because Appellants are placed in a position of unfair advantage by the Examiner relying on some phantom prior art of which Appellants are not aware and have not been made aware by the Examiner.

In any event, it is clear from the Examiner’s attempt to now offer some untenable rationale at this late stage of the prosecution that even the Examiner has finally acknowledged that the claim 17 feature of “confirming the location of the mobile station responsive to the signalling location, to ensure the location corresponds to the area of interest” is nowhere taught or suggested by the applied references.

IV. CONCLUSION AND PRAYER FOR RELIEF

Appellants, therefore, request the Honorable Board to reverse each of the Examiner's rejections.

Respectfully Submitted,

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March 24, 2011
Date

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